

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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INTERNATIONAL CODE COUNCIL, : Case No.: 17-cv-6261

INC, et al., :

Plaintiffs,:

v. :

UPCODES, INC., et al., : New York, New York

Defendants.: August 1, 2023

-----:

TRANSCRIPT OF STATUS CONFERENCE HEARING

BEFORE THE HONORABLE VALERIE FIGUERO

UNITED STATES MAGISTRATE JUDGE

APPEARANCES:

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1 THE DEPUTY CLERK: This is the matter of  
2 International Code Council, Inc., et al., versus  
3 UpCodes, Inc., et al.; Case Number: 17-cv-6261. The  
4 Honorable Valerie Figueredo presiding.

5 Counsel, can you please give your  
6 appearances for the record, starting with  
7 plaintiffs' counsel.

8 MS. WISE: Good morning. My name is Jane  
9 Wise, counsel on behalf of International Code  
10 Council, or ICC, and I'm joined by Kevin Fee and  
11 Gabby Velkes.

12 THE DEPUTY CLERK: Defense?

13 MR. MARCISZEWSKI: Hi. This is Mark  
14 Marciszewski on behalf of the defendant UpCodes, and  
15 I'm joined by Gene Novikov.

16 THE COURT: Good morning, everyone. This  
17 is Judge Figueredo.

18 So I have your two letters concerning the  
19 discovery dispute, ECF 172 and 179. I think it  
20 probably makes sense to just walk through the  
21 various RFPs that are at issue. But before we do  
22 that, I just -- you know, in reading the letters, I  
23 was just a little confused as to what a reading room  
24 is. And I think this came up in ICC's letter, so,  
25 Ms. Wise or Mr. Fee or Ms. Velkes, if you want to

1 just give me some context for what a reading room  
2 is...

3 MS. WISE: Sure. I'd be happy to do  
4 that. This is Ms. Wise.

5 A reading room in this context is simply  
6 ICC's website. It's an area on ICC's website where  
7 it makes all of its model building codes and various  
8 standards available to view for free, but there are  
9 limitations on what you can do from that website.  
10 So if you have Internet of any kind, whether it's on  
11 your cell phone, a tablet or on a traditional  
12 computer, you can go to ICC, click on codes, and  
13 then select from any of the 50 states that they have  
14 codes available for and review, for example, the  
15 Building Code of 2021 for a particular state. And  
16 you can do that by chapter and look at all of the  
17 various code provisions that you want to.

18 One of the disputes between the parties  
19 is, sort of, the functionality of that. So UpCodes,  
20 in its letter, talked about the ability to copy and  
21 paste, so that's not something that you can do from  
22 ICC's reading room. So when we refer to it as a  
23 "reading room," it's really the fact that it's free,  
24 but it's in a read-only format, so it can't be  
25 downloaded or copied and pasted into another

1 document.

2 THE COURT: Okay. And this -- so -- and  
3 this, I guess, is specific to Requests 2 and 3,  
4 which offer the reading code available to the public  
5 for free?

6 MS. WISE: I believe it's 2, 3 and 8.

7 MR. MARCISZEWSKI: Yes, that's correct,  
8 2, 3 and 8.

9 THE COURT: And so number 2 seeks all  
10 documents relating to this -- I guess, to this  
11 ability to look at the code in the reading room for  
12 free.

13 MS. WISE: Yeah. It says, "The free  
14 online services through which ICC's code can be  
15 accessed."

16 I think it's probably a little bit  
17 broader than just ICC's reading room. There may be,  
18 you know, another read-only source where ICC links  
19 for a particular jurisdiction. But, yes, that's  
20 essentially what Request 2 is talking about.

21 THE COURT: And so, Mr. Marciszewski --  
22 did I -- I'm sure I'm butchering that.

23 MR. MARCISZEWSKI: Yeah, that's -- it's  
24 fine. It's Marciszewski. Thank you.

25 THE COURT: I'm just trying to

1 understand. You say you want, for example, feedback  
2 from users concerning the practical effect of the  
3 restrictions ICC puts on its access.

4 So is there, like, a comment board on  
5 this reading room, or, I guess, you anticipate that  
6 someone accessing this would send an e-mail and say,  
7 I can't copy and paste this?

8 MR. MARCISZEWSKI: Yes. That's  
9 essentially what RFP 8 is about. And, yes, I think  
10 it's mainly also fair that we can pick certain  
11 custodians if there is certain -- an e-mail address  
12 customers send complaints to if they come in and say  
13 I can't copy and paste, or I can't do X and Y, and,  
14 therefore, this code is completely unusable to me.  
15 That's something that's relevant then to Upcodes'  
16 due process arguments that if -- this free access is  
17 not actually making the codes practically available  
18 to the public.

19 MS. WISE: And I'm happy to respond to  
20 that.

21 THE COURT: Sure.

22 MS. WISE: I'm sorry. I'm having a  
23 little trouble hearing. Did you say something,  
24 Judge?

25 THE COURT: No. Yeah, yeah, yeah. Go

1 ahead.

2 MS. WISE: So I think there's a real  
3 conflation of issues here on the sort of -- the  
4 technical aspects of what users can do. When  
5 Mr. Marciszewski says that it's not "practically  
6 available" to them, what he's saying is that you  
7 can't copy and paste, you can't print out from the  
8 website. Those are not due process issues. Due  
9 process has to do with whether there's access to the  
10 information. And if they can read it, it's our  
11 position that it's just -- the additional  
12 functionality, which ICC does make available through  
13 a licensed form, is really a different issue.

14 But more to the point, if they want to  
15 make this argument that ICC limits the way that you  
16 can access the codes because you can't copy and  
17 paste, they can do that. They don't need documents.  
18 We are willing to stipulate that we make a free,  
19 read-only version of the website. We had this  
20 information as a live issue in the first copyright  
21 case. The parties have already had a full dispute  
22 through summary judgment in which ICC had the same  
23 read-only access through its reading room to its  
24 codes. And they're welcome to make those arguments  
25 again.

1           But what doesn't make sense to us is to  
2     have ICC search for a really burdensome request that  
3     is all documents and communications relating to  
4     feedback, which is not time-limited or otherwise  
5     limited, and would include requests like, gee, I  
6     really wish your website had larger font. Things  
7     that are just wholly irrelevant to this case when  
8     they don't need them to make the argument that  
9     Mr. Marciszewski is advancing, that read-only access  
10    is not enough, it needs to be searchable, or it  
11    needs to be able to be copied and pasted.

12           MR. MARCISZEWSKI: And real quick, if I  
13    may respond to that, Your Honor, I just want to  
14    point out that opposing counsel's description of  
15    what the due process standard is saying just because  
16    it's available to be read-only is enough. That is  
17    something that's a live dispute in this case, about  
18    if just having it where you can read it is enough,  
19    versus does it actually need to be, you know, like I  
20    say, "practically available," or usable to the  
21    general public.

22           THE COURT: Because I guess I'm confused  
23    as to why someone's, you know, potential complaint  
24    about that would be information you need to make the  
25    argument.

1           MR. MARCISZEWSKI: I think there's a  
2 difference of, you know, if there's one person  
3 making a claim versus if there is a series and it  
4 shows, you know, in the documents we get that  
5 everyone trying to use ICC free access, it's just  
6 not usable in their practical -- you know, what they  
7 use it for, their job. I think that will then  
8 become relevant to our argument saying, hey, this  
9 free access is not usable by anyone. Here's a long  
10 litany of people saying they cannot use it. And,  
11 you know, that would be our argument.

12           MS. WISE: I just don't -- you know, the  
13 volume here is so large that that, to me, doesn't  
14 really change the analysis. They do not need the  
15 search of comprehensive documents and communications  
16 regarding all feedback whatsoever from users with  
17 respect to our codes on our free website to make  
18 this argument. It seems much more like a broad  
19 fishing expedition.

20           MR. MARCISZEWSKI: And, Your Honor, we  
21 are more than willing to also narrow this scope,  
22 either by certain custodians at -- or certain e-mail  
23 addresses, certain search terms. We are willing to  
24 narrow this. It's just -- we have not gotten to  
25 that point in meet and confer because of ICC's



1 position that it's not relevant, but we are more  
2 than willing to really limit it to, I feel like,  
3 actual customer communications. You know, maybe  
4 it's not so much the broad documents, but -- so  
5 really what we're searching for is the actual  
6 customer communications to ICC.

7 THE COURT: Ms. Wise, you keep talking  
8 about burden. Do you -- how -- what is the volume  
9 of documents? Have you run, like, an initial search  
10 to see how many potential consumer or customer  
11 complaints there are?

12 MS. WISE: We have not. We have not  
13 searched for this because, like I said, we haven't  
14 seen any showing from the other side that it's  
15 relevant. But we have, in the context of our prior  
16 dispute before Your Honor, gone back and started to  
17 pull documents on consumer information, and we've  
18 collected lots of data. There are multiple e-mail  
19 inboxes through which ICC receives communications.

20 And, like I said, I think it would be  
21 very difficult to, you know, sort the wheat from the  
22 chaff on this. I don't know how we would get to, I  
23 wish we could copy and paste -- which we're, again,  
24 willing to concede that they can't -- from I wish  
25 your font was bigger or I wish the format of the

1 website was different. Things like that. I think  
2 we would have to review, you know, years of  
3 documents from consumers to find something that  
4 we're willing to stipulate they can't do.

5 THE COURT: Okay.

6 MS. WISE: And just for context, the  
7 consumer -- the customer databases that we've pulled  
8 have millions of documents in them.

9 MR. MARCISZEWSKI: And, Judge, just one  
10 more point of relevance. I mean, ICC has made the  
11 assertions over and over in this case that not only  
12 are the codes available on the website, but the fact  
13 that they're easily accessible and anyone from the  
14 public can easily access and use them in the format  
15 they are in -- if ICC wants to continue making that  
16 argument, particularly with due process, UpCodes'  
17 position is that we're entitled to at least  
18 something. We can think about the narrowed scope of  
19 it, but we are entitled to document, to test whether  
20 that assertion is true or not.

21 MS. WISE: I just don't see how that's  
22 true. You -- UpCodes has sought summary judgment on  
23 this issue before without this information, so  
24 you're certainly capable of making the due process  
25 argument, and have made in the past the due process

1 argument, based on the read-only component of our  
2 website.

3 The ease of use, you know, if you want to  
4 walk the jury through our website and say, see how  
5 unfriendly it is, see how difficult it is to use our  
6 website, go for it. If you want to get an expert or  
7 run a survey that says, their website is difficult  
8 for these reasons, go ahead. But I don't think  
9 searching through, you know, a million documents is  
10 proportional to the cost in this case, where there's  
11 just no dispute that we don't make documents  
12 searchable.

13 THE COURT: Okay. So I think on RFP 8,  
14 I'm struggling to see why requiring these searches  
15 is necessary, given that the information seems to be  
16 something that you can easily stipulate to and is,  
17 you know, available just by virtue of going to the  
18 reading room. And they don't dispute that there is  
19 no ability to search or copy/paste or any of that.

20 MR. MARCISZEWSKI: I guess our position,  
21 the slight distinction is not just that what -- it's  
22 not that we want to know what are the features. We  
23 know what the features are. It's just that what is  
24 the effect of the people that are actually using it  
25 we find more relevant than if -- you know, if we

1 walk the jury through and the attorney's making the  
2 argument and we have no backing of what ICC users  
3 actually think about it. I think that's really the  
4 relevance of what we're looking for.

5 We can make that argument saying this  
6 isn't usable, it's not usable, but it just begs the  
7 question of, well, you say that, what do ICC users  
8 actually think? Can they use it? And that's why --

9 MS. WISE: Well --

10 MR. MARCISZEWSKI: -- we wanted customer  
11 feedback.

12 MS. WISE: Go ahead. I didn't mean to  
13 interrupt.

14 And we did point this out in our letter,  
15 that if, let's say, ten consumers in the last five  
16 years have wrote in and said, you can't copy and  
17 paste, they can't extrapolate that to a universe of  
18 all ICC users having that complaint, even if we  
19 produced those documents.

20 What they would need to run, like you do  
21 in many, many trademark cases to prove consumer  
22 beliefs is run a survey and find an appreciable  
23 number of users that can be extrapolated to the  
24 right universe of users. And that's how you tell  
25 what consumers are thinking. It's not by

1       cherrypicking one-off e-mails about what a  
2       particular consumer might want or wish or dream.

3               MR. MARCISZEWSKI: And, Your Honor, just  
4       the point is, I think there is a point of, if these  
5       documents come back and there's only two, five, ten  
6       e-mails, I think opposing counsel is right, that  
7       that turns into very cherrypicking, and they have  
8       every right to make that argument. But I think it  
9       just depends on the volume of complaints that come  
10      back. If it's hundreds and hundreds versus ten,  
11      that changes the calculus. But without even  
12      searching the documents, we don't know -- at least  
13      UpCodes does not know -- the volume of those  
14      complaints or feedback.

15             THE COURT: It sounded like, though, I  
16      heard Ms. Wise say that there wasn't -- you know,  
17      they have potentially, you know, a -- quite a  
18      sizable volume of these e-mails, and there's no way  
19      to limit the search accurately to just talk about  
20      complaints about the usability.

21             Is that correct, Ms. Wise?

22             MS. WISE: Yes.

23             MR. MARCISZEWSKI: And that -- I would  
24      just ask -- I mean, we can figure out search terms  
25      of just the actual usability that we're looking for;

1     either the words "copy/paste," the words "print," or  
2     something like that, that -- I don't know if -- we  
3     have not -- I don't believe ICC has run searches  
4     regarding maybe a narrow scope of certain inboxes  
5     for certain terms that highlight the functionality  
6     differences between ICC, a website and UpCodes'  
7     website that ICC has been pointing out.

8                 But I believe if we do something -- if we  
9     can agree to certain, you know, inboxes and certain  
10    search terms -- I still could be wrong because I  
11    don't know the inboxes, but it could narrow down  
12    from -- it's not going to be millions anymore.

13                MS. WISE: I still think that that's the  
14    tail wagging the dog on its relevance, right? You  
15    know, if we have to search through these inboxes, I  
16    think it's going to yield a high volume of hits.  
17    Just from the searching that we've done in other  
18    contexts, I really think that the volume is going to  
19    be quite high.

20                But at the end of the day, they would  
21    still need some expert analysis to say that the  
22    number that we receive is meaningful in some way,  
23    and they can do that with a survey without us  
24    looking for a single document.

25                THE COURT: All right. Let's just keep

1 moving on. There's still 2 and 3 in this section.

2 I think on number 8, for the reasons I've  
3 indicated, I'm not entirely sure why this  
4 information is not something that what you really  
5 think just shouldn't be done through a consumer  
6 survey. But I'm going to just table this a second  
7 because it does sound like there weren't any  
8 searches done initially to try to understand the  
9 volume that we were talking about, and it would be  
10 on ICC's -- it is ICC's burden to show that this  
11 would be unduly burdensome.

12 Although I am still struggling to see the  
13 relevance, so I understand your argument, Ms. Wise.  
14 But since 2 and 3 are in the same category, do we  
15 want to discuss those?

16 MR. MARCISZEWSKI: Yes, Your Honor.

17 Briefly, I just want to make the  
18 distinction with 2 and 3. The -- we've talked about  
19 due process a lot with 8. I think 2 and 3 are most  
20 relevant, more so to the market harm analysis of the  
21 fair use. It's mainly whether ICC offering its  
22 codes online for free, albeit with these certain  
23 limitations that they've talked about, if they've  
24 affected ICC's revenues or sales because it's ICC's  
25 central argument that UpCodes offering the law for

1 free harms the market for ICC codes. And if ICC's  
2 offerings -- if there's documents out there that  
3 says that has not affected their book sales or  
4 revenues, that would be relevant, therefore, to  
5 market harm.

6 And I know in the letters ICC has pointed  
7 out these functionality differences, but I believe  
8 getting these documents also will allow UpCodes to  
9 test whether those distinctions were actually  
10 considered when making these offerings. For  
11 example, if there's a document out there that says,  
12 hey, it's on a read-only format, but anyone can hit  
13 CTRL-P and print the page, are we concerned about  
14 that; and says, no, that's fine if people start  
15 printing it, it's not going to affect our book  
16 revenues, that's relevant.

17 Or on the flip side, if all decisions end  
18 to make the codes available for free, or after the  
19 fact, when discussing in relation to their revenues,  
20 that "copy, paste, print" never come up, then I  
21 think UpCodes is entitled to test whether this has  
22 been a consideration by ICC all along or if this is  
23 a theory just by litigation to make a distinction  
24 between UpCodes' and ICC's services that is a  
25 distinction without a difference.



1 MS. WISE: If that's -- if you're done,  
2 Mr. Marciszewski, I'll go ahead and respond.

3 MR. MARCISZEWSKI: Yes.

4 MS. WISE: The notion that something that  
5 happened several years before UpCodes existed was a  
6 litigation strategy strikes me as untenable. ICC,  
7 long before UpCodes existed, made its documents  
8 available in a read-only format for customers to go  
9 to its website. The decision-making process, as  
10 Judge Freeman already ruled, is not relevant once  
11 you know that we've made them available for free.  
12 That's just the fact. Whether ICC considered, you  
13 know, how many views to give people for free, or  
14 did -- you know, how -- should we track access or  
15 not; those are all within the scope of the request.

16 And I think one thing that we haven't  
17 really talked about is the narrowing that UpCodes is  
18 doing now to copy and paste. It didn't do so in the  
19 meet and confer. And so we haven't run search terms  
20 to limit the scope to meet and confer because that's  
21 not the scope of the request. The request as  
22 written, including number 8, requests all documents  
23 concerning free online access to services, which is  
24 number 2. And that's much broader than it's being  
25 painted here.

1           So our concern about the breadth of these  
2           requests is this volume of consumer requests that we  
3           get through these channels. It's huge. And UpCodes  
4           has not shown that they're willing to limit them in  
5           any way. And, frankly, we don't think they need  
6           them. As Judge Freeman said, it -- ICC freely  
7           admits that they make documents available for free  
8           on their website, and we did throughout the entire  
9           first copyright case.

10           A big portion of that case was fair use.  
11           Notably, they never raised this argument the first  
12           time they sought these documents, so they clearly  
13           didn't think it was that important at that time.  
14           But even Judge Marrero said that UpCodes' use is  
15           different in kind. We're not comparing apples and  
16           apples. We're comparing apples and oranges. ICC  
17           makes its documents available in a read-only format.  
18           That means people cannot send them to their friend.  
19           They can send the link to the website to their  
20           friend.

21           From UpCodes, you can do exactly the  
22           opposite. You can copy language and you can put it  
23           in an e-mail, you can copy entire code books. And  
24           that is substitutional to ICC's use. And that's  
25           right in Judge Marrero's opinion about the market

1       harm on Factor 4. So if they were able to brief  
2       summary judgment and make this argument without  
3       these documents last time, we simply don't see why  
4       ICC should undergo the burden of searching millions  
5       of documents this time around when it seems entirely  
6       unnecessary and disproportionate.

7               MR. MARCISZEWSKI: And, Your Honor, just  
8       a few clarifying things.

9               I think opposing counsel is right when we  
10      talk about RFP 8, about limiting to the  
11      functionalities of copy/paste. But I think in 2 and  
12      3, what we're -- what UpCodes is really more looking  
13      for are more internal documents, you know. And  
14      we're willing to think about a universe of maybe  
15      more formal documents or board presentations and  
16      minutes, that we're really looking at the market  
17      harm on that one more so than the distinguishing  
18      features. It's that offering the codes for free  
19      online, has that affected ICC's revenues? That is  
20      really the question there.

21              And just a real point with Judge Freeman,  
22      talked about the decision-making in the prior  
23      hearing. He said regarding due process, the  
24      decision isn't really relevant to due process  
25      because it was -- it's either available or it's not,

1 or the features are what they are. That was his  
2 logic. He did not discuss regarding market harm,  
3 which these really go to, are the potential market  
4 harm because, it's -- you know, as opposing counsel  
5 points out, their argument is going to be UpCodes  
6 and ICC is apples-to-oranges comparison, you can't  
7 make it. And that's fine, that when, you know, we  
8 get to a brief, then we can make that argument. But  
9 it does not mean that we're not entitled to at least  
10 get these documents to say, hey, ICC's free offering  
11 does not affect their revenues at all, if that is  
12 true, if there's documents that say that.

13 And then, you know, it would be UpCodes'  
14 then position and our argument that will say that  
15 UpCodes' offering is similar enough to ICC's that it  
16 would not affect the market. Obviously, opposing  
17 counsel will disagree with that position, but that  
18 legal argument and that, that it was at summary  
19 judgment last time and will probably be briefed  
20 again, isn't a stop to allow UpCodes for some of  
21 these documents in order to at least get that  
22 information whether ICC's free offerings has  
23 affected their revenues and sales.

24 THE COURT: Ms. Wise, what about the --  
25 since it sounds like the parties hadn't really

1 looked at narrowing the request, why is narrowing 2  
2 and 3 to look at specifically any impact on revenues  
3 or other income streams from offering it for free  
4 online? Would that not adequately address your  
5 concern that this is potentially looking at, you  
6 know, millions of irrelevant documents?

7 MS. WISE: I think the best answer to  
8 that is that they're getting those documents in  
9 response to other requests. So when Mr.  
10 Marciszewski talks about getting data to compare, we  
11 are producing documents responsive to views of ICC's  
12 free website. We're producing documents about how  
13 that compares to our paid-license services. So if  
14 they want to say, you know, since the time that ICC  
15 introduced the free online website -- they can  
16 compare that to the paid version with the documents  
17 that we're going to produce.

18 What we don't think are relevant are  
19 individual employee e-mails about the decision back  
20 in -- I don't know the exact time frame, but I'm  
21 going to say 2012 because I believe it was live  
22 in -- later than that. So for just frame of  
23 reference, in 2012 the documents that ICC considered  
24 about whether to offer the access for free just  
25 doesn't strike us as relevant. And, you know, the

1 marketplace is how it exists now, not all the  
2 options that ICC considered in making the decision  
3 whether to offer it or not.

4 And I do think -- just to reframe a  
5 little bit and respond to what Mr. Marciszewski was  
6 saying about Judge Marrero's decision, our point is  
7 not that these issues have been decided. Our point  
8 was that they had sought documents regarding this  
9 decision making in the last case, the *Copyright 1*  
10 case. And this case is very similar in terms of the  
11 issues that the parties disputed, and they didn't  
12 get these documents because they were found to be  
13 irrelevant.

14 We understand that last time they argued  
15 due process and didn't choose to argue this fair  
16 use, that's certainly their choice not to have  
17 pursued it at that time, but they still made this  
18 argument about our free offering impacting market  
19 harm. So if they're making that argument and  
20 Judge Marrero just, you know, considered it, they  
21 don't need these documents.

22 THE COURT: Although it sounds like you  
23 started off by saying they were already getting it  
24 from other sources.

25 MS. WISE: No. They're getting the --

1 the documents that they're getting from other  
2 sources are the data of the -- to make a comparison  
3 between our free offering and our paid offering.  
4 They don't need -- the documents that they don't  
5 need are internal communications about decisions to  
6 offer free access or internal communications about  
7 how our website -- how our codes can be accessed.

8 MR. MARCISZEWSKI: And, Your Honor, just  
9 to put a point, clarify something I might have said  
10 earlier is we're willing to, kind of, start  
11 narrowing this because, again, we've had disputes  
12 about more relevance. We get that we're maybe  
13 getting the data from somewhere else. But what we  
14 also think is relevant is not every single  
15 employee's e-mail, but if things are -- you know,  
16 were discussed at a board meeting, or if there was a  
17 PowerPoint at a board presentation, or maybe e-mails  
18 among executives about the free offerings, that  
19 then -- that those free offerings -- you know, not  
20 just so much the decision the first time, but  
21 whether to continue doing it.

22 If it says, hey, is the free offering  
23 hurting our sales? No, it's not, let's continue  
24 doing it. Or this -- whatever they might say in  
25 those documents, that's really what we are looking

1       for, is not just the raw data that maybe we can make  
2       extrapolations from, but whether ICC itself has  
3       noticed that this, you know, offering that it has  
4       hasn't affected its book sales or isn't hurting its  
5       revenue streams. That is what really -- that's,  
6       kind of, the fine point of what we're looking for.

7               THE COURT: The free offering began in  
8       2012, I think someone said.

9               MS. WISE: I think discussions about the  
10       free offering would have been around that time,  
11       yeah.

12              THE COURT: And when did UpCodes enter  
13       the market?

14              MS. WISE: Around 2017. You all may know  
15       better than I do, but the lawsuit was certainly  
16       2017; so maybe shortly before that.

17              MR. MARCISZEWSKI: That's correct.

18              THE COURT: Okay. So I guess, Ms. Wise,  
19       I'm just -- it sounds like defense counsel has, at  
20       least, substantially narrowed this request. And  
21       we're talking about -- it doesn't even seem like  
22       this internal communication so much as, like, you  
23       know, formal presentations or documents outlining  
24       the potential, you know, loss in revenues of any or  
25       market harm from offering the service for free. And



1 I thought I heard you say that that would not be  
2 information they would get from another request.

3 MS. WISE: I --

4 THE COURT: But it also doesn't seem like  
5 this would be voluminous or burdensome.

6 MS. WISE: I'm trying to think if it  
7 would be in other requests. I honestly don't -- I  
8 hadn't considered that. I think one of the  
9 struggles that I'm having here is that there was a  
10 long meet and confer process, and the motion that's  
11 before Your Honor is on the request as written.  
12 They have not, prior to now, offered to narrow. And  
13 so I could have investigated, you know, potential  
14 narrowings before now.

15 I think the appropriate response would be  
16 to deny the motion. That -- the requests, as  
17 written, are extremely overly broad, as Counsel has  
18 showed by jumping to narrow it immediately. As  
19 written, they're just not relevant and are already  
20 demonstrated by the access that ICC makes available.  
21 I'm not sure what a board document from 2012 is  
22 going to tell them about ICC's current marketplace  
23 and the harm that UpCodes' substantially different  
24 use is going to show.

25 THE COURT: Okay. Look, I hear the -- it

1 sounds like the motion potentially could have been  
2 avoided, but we're here now. I agree that, as  
3 written, Requests 2 and 3 are too broad, but it  
4 sounds like there's potentially a far narrower  
5 request that can be considered.

6 And I -- you know, unless you want to  
7 point me to specifically where this was already  
8 considered before either Judge Freeman or Judge  
9 Marrero, I'm happy to look at that, but it sounded  
10 like maybe the request made then was also different  
11 than the more narrow request we're talking about  
12 now.

13 I sort of -- I do actually see his  
14 argument on relevance for this far narrow request  
15 when he's -- when we're looking at the decision to  
16 have even offered this for free in the initial  
17 instance, about whether it would have affected, you  
18 know, their potential revenue sources. But it does  
19 sound like there's potentially some resolution here  
20 that, at least, could be considered before -- you  
21 know, before a final ruling on 2 and 3.

22 But -- so just to take a step back, as  
23 written, I agree with you, 2 and 3 are too broad,  
24 but Counsel has offered something far narrower, and  
25 since that wasn't considered by the parties, I'd

1     like the parties to just, at least, go and figure  
2     out whether this is -- whether, in fact, these  
3     documents exist and whether they would be voluminous  
4     or burdensome to search for. Because it does sound  
5     like he's looking -- he's no longer looking for  
6     internal communications.

7             MS. WISE: So, if possible, I think one  
8     solution would be for UpCodes to serve a narrowed  
9     request so that we can look at it and then start to  
10    evaluate the request on its face. Because I think  
11    what's happened in the discussion process is I don't  
12    have a, you know, actual request to look from. I  
13    can go with my understanding of how it's narrowed,  
14    but then the parties are just going to have a  
15    dispute about, you know, what exactly did we agree  
16    to. If UpCodes is willing to serve a narrowed  
17    request, we'd be happy to look at it.

18            THE COURT: Okay. Sure. Go ahead.

19            MR. MARCISZEWSKI: Sorry, Your Honor. I  
20    just wanted to point out that during the meet and  
21    confer process, although there was not any  
22    formalized offers of narrowing, we -- UpCodes showed  
23    the willingness -- I mean, particularly on 8 from my  
24    notes, that, hey, we can have certain custodians, we  
25    can limit this in time. There was -- you know,

1       offered up, but ICC really stood on the grounds that  
2       none of these are relevant whatsoever.

3               And I think, even from Counsel's point  
4       that some of these documents seem to also -- being  
5       produced maybe in other requests, shows that there's  
6       at least -- you know, maybe they're a bit too far  
7       broad, but they are, at least, relevant. And I  
8       think just having that to go back -- instead of  
9       coming up with new requests that we're going to try  
10      and start this process all over, to have a  
11      meaningful meet and confer about how this can be  
12      narrowed in a way that alleviates burden would it be  
13      helpful with the knowledge that, hey, these  
14      documents are relevant now. And it, kind of, would  
15      push us through that impasse on the relevance  
16      argument.

17             MS. WISE: Is it -- my understanding  
18      that -- I don't think -- Judge, did you say that you  
19      thought Request 8 was relevant? Because I don't  
20      think limiting --

21             THE COURT: No. I wasn't speaking about  
22      Request 8. I was speaking specifically about 2 and  
23      3.

24             MR. MARCISZEWSKI: Yes.

25             THE COURT: Right.

1 MR. MARCISZEWSKI: And I apologize. I  
2 did not mean to queue it that way.

3 THE COURT: Sorry. Sorry. I just -- I'm  
4 just really talking about 2 and 3. I get that this  
5 process seems to have been -- it's moving a little  
6 bit backwards, given that there wasn't, you know, a  
7 formal narrowed request served.

8 I think what I was specifically talking  
9 about was this idea that there would be something  
10 other than internal communication. So formal  
11 presentation is, I think, what Mr. Marciszewski had  
12 indicated. And at least once we get out of the  
13 bucket of internal communications, there had been no  
14 indication from Ms. Wise that these -- that there  
15 would -- that this request would be unduly  
16 burdensome when we're just looking at any analysis  
17 that was done with regards to the -- with regards to  
18 the impact of revenues from a free offering of the  
19 codes, so...

20 MS. WISE: I just don't know the answer  
21 to that. I do want to reserve the right to say that  
22 it might be. I just haven't -- we're so far down  
23 the path of a different request than what this  
24 motion to compel was initially about that I just  
25 don't know.

1           THE COURT: Yeah, no, and I hear that,  
2           and so that's why I had suggested, you know, if the  
3           parties can go back and, sort of, figure out if this  
4           request can be narrowed in the way that's been  
5           indicated on the phone call and whether that would  
6           pose, you know, a voluminous -- would produce a  
7           voluminous amount of documents.

8           If what you want is a -- you know, an  
9           updated formal request, I don't think that should be  
10          something that's too hard to put together, since  
11          it's -- it is, like -- we've, now, very much  
12          substantively limited the request.

13          MR. MARCISZEWSKI: That works for  
14          UpCodes, Your Honor.

15          THE COURT: Okay. And then with regards  
16          to 8, as I had indicated, you know, I still don't  
17          see why this information is necessary, given that  
18          they're willing to stipulate to it, and you would  
19          otherwise have to use a survey to show, you know,  
20          customer preferences or functionality or use and the  
21          difficulties arising from the fact that you can't  
22          copy and paste and the like.

23          But if you want to point me to a case or  
24          something else that would -- that could potentially  
25          change my mind, I'm happy to look at it, but as it

1 stands on number 8, I'm not -- I think, as written  
2 in the motion, I'm going to deny -- I'm going to  
3 deny the motion to compel on that one.

4 MR. MARCISZEWSKI: Thank you, Your Honor.

5 THE COURT: I think the next category is  
6 15 and 17.

7 MR. MARCISZEWSKI: Yes, Your Honor. I  
8 think it might also be easier just to take 17 by  
9 itself because I believe ICC has written in their  
10 response that they're willing to search for, I  
11 believe, documents sufficient to show whether ICC  
12 intended or encouraged jurisdictions to adopt codes  
13 into law.

14 And I think this really stems from --  
15 many courts consider, and I believe this Court in  
16 its previous order has considered whether a  
17 privately authored work becomes the law on  
18 government adoption. One of the factors that can be  
19 considered is whether ICC intends or encouraged that  
20 work to be adopted into law.

21 Our only position is -- we're okay --  
22 that was -- the point of our original RFP was we  
23 read it as whether ICC intended or encouraged  
24 jurisdictions to adopt codes into law. We would  
25 just still push that we want the -- you know, all

1 documents, communications, related to that rather  
2 than sufficient to show because it's, kind of, an  
3 open question of whether ICC does that or not. And  
4 I feel like ICC might have a different position than  
5 us. So we would just then say we want all document  
6 comms regarding whether ICC intended or encouraged  
7 jurisdictions to adopt codes into law.

8 MS. WISE: I'm sorry. I'm at a little  
9 bit of a loss. I understood Request 7 to seek --  
10 I'm sorry -- 17 to ask for "documents and  
11 communications related to lobbying efforts,  
12 including communications with lobbyists regarding  
13 your adoption."

14 And in UpCodes' brief, they said that  
15 that was because they wanted -- they believed that  
16 those documents show whether ICC intended or  
17 encouraged the work's adoption into law. And in  
18 response to that, we are willing to provide  
19 documents sufficient to show whether ICC intended or  
20 encouraged the work's adoption into law.

21 Those documents were provided in  
22 *Copyright 1*. In terms of Judge Marrero's decision,  
23 he found there was no -- it's undisputed that ICC  
24 encourages adoption of its codes, pointing to some  
25 sample ordinances that ICC had produced. We are



1 willing to produce similar documents for the  
2 additional codes in this case. And I don't think  
3 the documents beyond that are necessary. Certainly  
4 not all documents and communications relating to  
5 lobbying efforts, which is how the request, as  
6 stated in the motion to compel was written.

7 THE COURT: Ms. Wise, can I -- exactly  
8 what are you willing -- what -- how would you be  
9 willing to limit the request and produce documents?

10 MS. WISE: We'd be willing to limit the  
11 request to documents sufficient to show ICC's intent  
12 or encouragement of the work's adoption into law.

13 THE COURT: Would that not include,  
14 potentially, lobbying efforts and communications  
15 with lobbyists?

16 MS. WISE: You know, I think "lobbying"  
17 is, kind of, a vague term as to what it means, but  
18 as it's written in the request, the lobbying efforts  
19 are entirely unrelated to adoption. So --

20 THE COURT: But now if you're limiting it  
21 to adoption, would it include, in your view,  
22 lobbying efforts to try to get a code adopted into  
23 law?

24 MS. WISE: I don't -- I don't think so.  
25 I think what we have, just for your context --

1 THE COURT: So how would the lobbying  
2 efforts not be something like -- why wouldn't that  
3 come with an encouraged?

4 MS. WISE: Because what we had asked was  
5 sufficient to show. So I don't think that what we  
6 had in mind was sufficient to show was that we would  
7 go through the vast number of people who deal with  
8 jurisdictions on a daily basis and determine on a  
9 document-by-document, e-mail-by-e-mail basis,  
10 whether a particular document was encouraging  
11 adoption.

12 What we do have are, at the start of each  
13 code book, there is sample ordinances, sample  
14 legislation, that is, you know, provided with ICC's  
15 code book that says, this is how you can adopt our  
16 code into law.

17 I don't know that they're going to get a  
18 clearer example of ICC intent or encouragement of  
19 adoption of its code book than a sample ordinance.  
20 So does it need individual communications with 50  
21 jurisdictions, with just states, and with every  
22 locality that ICC, true to its word with the sample  
23 ordinances is intending that they be adopted?

24 THE COURT: And so for every code that  
25 you have, you have this sample ordinance or

1       legislation that for each one provides how the  
2       process could be done to adopt it into law?

3               MS. WISE: I believe so, yeah.

4               THE COURT: And just going back to  
5       defense counsel, why is that not sufficient?

6               MR. MARCISZEWSKI: I believe that might  
7       be sufficient. The issue that I had originally is  
8       that it was just confusing to say "sufficient to  
9       show" whether ICC does something or not. It just  
10      leaves open the question of if ICC is going to give  
11      documents to show that it's not lobbying or  
12      intentting, or if it was.

13              That was, kind of, the concern I had,  
14      that it was confusing, the limitation, as it was  
15      written. That if -- really, if it comes to  
16      documents, there -- I think we're willing to be okay  
17      with that "sufficient to show" if it's truly --  
18      these are documents that show they are encouraging  
19      and they want to adopt into law, that's fine. Or  
20      even if ICC is willing to stipulate, saying, we  
21      encourage every single one of our codes to be  
22      adopted into law, that's really what we're trying to  
23      get at. And that's fine, too, that -- if ICC has  
24      that type of position.

25              And last, I just want to point out,

1 Your Honor, I might be moving backward, but the  
2 original RFP was talking about -- regarding adoption  
3 of your codes. So that's really that -- that point  
4 of it because they're willing to stipulate to it. I  
5 don't think we really care about the internal  
6 communications or the communications with  
7 jurisdictions if that's just going to be duplicative  
8 and not necessary.

9 THE COURT: Let me just -- let me just  
10 ask.

11 Even absent a stipulation, though, if  
12 she's saying that they have these, basically a  
13 how-to adopt this -- how -- a step-by-step guide or  
14 some sample document that explains how it should  
15 be -- how it can be adopted into law, that seems to  
16 me to be sufficient to show that they're encouraging  
17 that the code be adopted into law, even if  
18 they're -- even if she's not going to agree to a  
19 stipulation on this.

20 MR. MARCISZEWSKI: Well, I mean,  
21 that's -- that would be fine. I think our concern  
22 is if that's all we have and then we make the  
23 argument later, and they come back and say, well,  
24 just because we print that at the beginning, that  
25 doesn't mean we're actually encouraging certain

1 jurisdictions to adopt it, and trying to gain --  
2 trying to, you know, weave that path through, that  
3 would be the issue.

4 But if -- what it sounds like -- at  
5 least, from opposing counsel's representations --  
6 that that's not likely to happen. I think we're  
7 okay with just the sample ordinances if it's not  
8 going to come back later, that ICC's going to try to  
9 make a distinction when we use that and say, look,  
10 they're encouraging, intending all of their works to  
11 be adopted into law.

12 THE COURT: Ms. Wise, I just want to, I  
13 guess, understand. That -- is -- that doesn't sound  
14 like an argument you'd be making later, but I guess  
15 now would be the time to clear that up if that is  
16 potentially something that would become an issue  
17 later.

18 MS. WISE: I -- so I don't think that  
19 we're willing to stipulate, particularly without  
20 conferring with our client. And I don't -- I think  
21 the words "adopted into law" have a really specific  
22 meaning in this case. I don't think we're trying to  
23 hide the ball. I don't think that we're trying to  
24 be unclear about what we're offering to give to  
25 them.

1           What we're more than happy to produce is  
2   what Judge Marrero relied on in the first copyright  
3   case, which are the sample ordinances that he  
4   show -- said, I think, along with some additional  
5   deposition testimony, was that it's undisputed that  
6   ICC encourages adoption of its codes. So I think  
7   what we're giving -- or what we're willing to give  
8   UpCodes has already been shown to be enough on this  
9   point. But I don't think I can go as far as a  
10   stipulation; certainly not without conferring with  
11   my client.

12           MR. MARCISZEWSKI: Your Honor, I  
13   completely understand about not wanting to stipulate  
14   right now in this hearing. I understand Counsel's  
15   position there.

16           But I'll just say what was just said,  
17   kind of, then starts begging the question of, are  
18   those, you know, sample ordinances a beginning? Is  
19   that just saying, hey, jurisdictions -- the  
20   argument -- jurisdictions, you can create laws like  
21   this, or this is a sample to work off of. Or  
22   whether, you know -- and this may be where  
23   communications come in -- someone tells a  
24   jurisdiction, hey, you can adopt our codes as-is  
25   into law, you know, and they can incorporate a

1 reference, or you adopt it by reference into law.  
2 That would then become where communications may be  
3 more relevant.

4 If we're starting to make that  
5 distinction of what does "adopt into law" mean,  
6 that, then, becomes a more trickier area if we're  
7 just relying on the sample ordinance and have  
8 nothing more versus if this is going to be a thinly  
9 lined argument about what a document law means,  
10 UpCodes would then want to see some of those  
11 communications and see if that language is used by  
12 ICC when communicating to jurisdictions.

13 THE COURT: Well -- so I guess I just --  
14 I'm -- you know, I just want to be clear on this. I  
15 had understood, I guess, Ms. Wise to be saying,  
16 look, we have these sample ordinance, sample  
17 legislation, it's provided for all our codes, and  
18 previously Judge Marrero found that is -- you know,  
19 it's undisputed that this is what encouraged the  
20 jurisdictions that ICC -- this showed that ICC  
21 encourages jurisdictions to adopt into law.

22 I think -- it sounds to me like what  
23 they're willing to provide you should be sufficient,  
24 absent some later argument that now quibbles over  
25 what "adoption" means. And so that's why I was

1     trying to ask, you know, not necessarily to a  
2     stipulation, but if there's going to be an issue --  
3     because maybe this didn't come up before  
4     Judge Marrero before, but if there was going to be  
5     an issue as to what "adoption" means, then I  
6     thought, you know, potentially our compromise here  
7     wouldn't necessarily make sense. But it's -- I'm  
8     not sure...

9             MS. WISE: I think the sticking point --  
10     and I'm sorry. I may have just interrupted you.

11            THE COURT: No. Go ahead.

12            MS. WISE: I think the sticking point is  
13     not whether ICC encourages adoption. It's the "into  
14     law," right? The parties have a big dispute about  
15     whether ICC maintains its copyright when  
16     jurisdictions incorporate their model codes and  
17     standards by reference, whether that then becomes  
18     the law. And, you know, in our conversations with  
19     UpCodes on their request, they've said, you know, we  
20     might not respond in the exact words that you use in  
21     your request because we don't want to have an  
22     inherent admission about the larger issues in this  
23     case. And that's all we're saying.

24            We're willing to give the documents that  
25     they want on this encouragement issue. I think that



1 it's been shown that those documents are going to  
2 be, you know, the ones that UpCodes intend to rely  
3 on. So I'm not really clear on why they're pushing  
4 for this now when they've relied on them in the  
5 past. But I don't think we're trying to be cute  
6 about it. We just are not going to admit something  
7 that has a bigger implication for the case.

8 THE COURT: Okay. Okay. So then I think  
9 as to 17, I get your position, Ms. Wise. I think we  
10 should -- as we've -- as you narrowed it in your  
11 letter and as we've discussed, the sample ordinance,  
12 sample legislation sufficient to show whether ICC  
13 intended or encouraged the work's adoption into law,  
14 it sounds like the parties have agreed on, at least,  
15 that narrowed request, and defense counsel is  
16 willing to accept that.

17 MR. MARCISZEWSKI: Yes, Your Honor.

18 THE COURT: Is there an issue as to 15  
19 then?

20 MR. MARCISZEWSKI: Yes. It -- 15 is --  
21 and I can -- it also probably relates a little  
22 bit -- the arguments I'm going to make for 18 are  
23 going to be pretty much the same.

24 The issues there are basically whether  
25 testing if ICC's positions -- in this case, if

1       they're making litigation -- and what their past  
2       positions are. So there's really two issues. It's  
3       about willful infringement of UpCodes and also, if  
4       nothing else, for impeachment purposes. Really ICC  
5       is making broad assertions of what the copyright is.  
6       And to the extent that this position is contrary to  
7       what positions ICC has taken before about the extent  
8       of its copyrights, UpCodes is entitled to that.

9               And as well as for willful infringement,  
10       ICC's belief to the extent of its copyright is  
11       relevant to whether UpCodes' belief was reasonable,  
12       whether it was, you know, willful infringement or  
13       not. For example, if there's documents out there  
14       that ICC believe that, when codes are adopted,  
15       they're the law and they can't be copyrighted, or  
16       even if there's documents saying that, hey, it's  
17       kind of unclear what this is, then that's relevant  
18       to whether UpCodes' belief at the time, that this is  
19       not copyrighted material, this is the law, and  
20       how -- whether, objectively, that was reasonable or  
21       not. ICC's same belief as the copyright owner, who  
22       should probably know even better, is then,  
23       therefore, relevant to whether UpCodes' belief was  
24       reasonable as to willful infringement.

25               THE COURT: Ms. Wise?

1 MS. WISE: I -- so first, I don't think  
2 ICC's -- well, ICC's belief is that it owns the  
3 copyright in all of these codes. It would not have  
4 brought a lawsuit in bad faith to begin with. To  
5 say that it doesn't have copyright privately and to  
6 bring more than one copyright lawsuit, I think,  
7 would be ludicrous.

8 But even setting that aside, ICC's  
9 subjective views on copyright protection just are  
10 irrelevant. The Supreme Court has weighed in on  
11 this, and they said that if you look at the purpose  
12 and character of the use, which is what UpCodes has  
13 said that this goes to in the fair-use analysis, the  
14 Supreme Court said that is an objective inquiry. So  
15 whether the work has copyright or not, I think the  
16 people to look to are the Copyright office, who has  
17 again and again, registered ICC's works.

18 All of the inquiry about whether UpCodes'  
19 beliefs are objectively reasonable go to what  
20 UpCodes knew. And UpCode didn't know anything about  
21 ICC's internal subjective views when it made these  
22 decisions. The case that they point to, this  
23 *Scanlon* case, I think, exemplifies that, right.

24 They have a copyright owner who provided  
25 certain works for certain purposes, and there was

1       ambiguity as to what defendants knew or didn't know  
2       about the policy of the organization where those  
3       images had been shared. So the willfulness inquiry  
4       in that case was really, you know, was defendant's  
5       belief about what the copyright policy of the  
6       organization was reasonable under the circumstances.

7               UpCodes didn't have any belief about  
8       ICC's subjective views. So I don't see how it  
9       informs anything about UpCodes' willfulness. The  
10       objective facts that UpCodes was aware of when it  
11       posted these new documents is that ICC had sued them  
12       once for copyright infringement. So their  
13       reasonableness or not reasonableness should be  
14       viewed in light of the circumstances when they chose  
15       to post the additional works, not internal ICC  
16       communication.

17              MR. MARCISZEWSKI: And, Your Honor, just  
18       really two quick points. First was brought up about  
19       the fair use being an objective test. That is true.  
20       It does not mean that any subjective views are  
21       completely irrelevant, it's just that the test that  
22       is used is an objective standard.

23              Moving really quick to the willful  
24       infringement point, our argument is not that UpCodes  
25       knew what ICC was thinking and, therefore, relied on

1     ICC. The point being is that the fact that UpCodes,  
2     at the time when making decisions, was equal if not  
3     less than the information that ICC had. And I'm not  
4     trying to suggest ICC is bringing these litigations  
5     in bad faith, that, you know -- that when they sue,  
6     they believe they have copyright and there has been  
7     copyright infringement. But if there is documents  
8     at some point when there was questions about it, or  
9     they didn't believe, or there was ambiguity, or they  
10    go, I'm not 100 percent sure, we need to figure this  
11    out. That ambiguity, as the copyright owner, who  
12    should know more than anyone, can show that there's,  
13    you know, gray lines here that doesn't show that  
14    UpCodes was willfully infringing.

15                 MS. WISE: So I guess what I'm --

16                 THE COURT: Can I just ask you a question  
17    on willful infringement, because just I -- the -- if  
18    UpCodes was aware that ICC was putting this  
19    information out under the color or cover of a  
20    copyright, I'm confused as to why whether ICC  
21    subjectively believed that maybe potentially its  
22    copyright either wasn't as strong or as it, you  
23    know, might have portrayed it to be, why that would  
24    go to what -- to the willfulness of UpCodes' conduct  
25    because UpCodes wouldn't have been aware of anything

1 ICC was thinking behind the scenes. It just knew  
2 that ICC had put this information out there and had  
3 indicated that it was copyright.

4 MR. MARCISZEWSKI: Right. Your Honor, it  
5 goes really to almost credibility of their argument  
6 of saying that there was willful infringement.  
7 Because UpCodes' position is that we are not copying  
8 ICC's copyrighted material. What we are posting is  
9 what is the law. And our position is that you  
10 cannot copyright what's in the law.

11 And there is -- you know, we can have --  
12 I don't want to devolve this into legal arguments  
13 here, but if there is internal communications at ICC  
14 saying, you know, once something's adopted into law,  
15 I'm not sure what copyright might have if it's  
16 identical to the law that might not be copyrighted.  
17 Those type of questions can show that even if the  
18 copyright owners think that there might be a  
19 question, that it's reasonable for UpCodes to  
20 believe that, if I'm posting the law, that is not  
21 copyright infringement. And that would be then  
22 relevant to the willful infringement analysis.

23 THE COURT: And wouldn't those  
24 communications that you're potentially pointing  
25 to -- it sounds like those should be almost -- could

1 potentially almost all be privileged.

2 MR. MARCISZEWSKI: Right. And I guess we  
3 are, obviously, not looking for any privileged  
4 documents. And we're willing to work, too, you  
5 know, if there's -- a privilege log might be another  
6 burden. If there's too many of that, then fine.  
7 And if it's -- if all of them are privileged and  
8 there's no documents -- the only time they've ever  
9 had this discussion is with counsel then -- and I'll  
10 have the position that it's an easy response to come  
11 back and say there's no documents that aren't  
12 privileged to it.

13 And that's the same for -- I guess that  
14 also relates to 18, about that *NFPA v. UpCodes*  
15 litigation. If all of those communications end up  
16 being privileged, then it's a fairly simple response  
17 of "they're all privileged," and we can work out  
18 whether a privilege log is necessary or not.

19 MS. WISE: I think that, sort of, jumps  
20 the preliminary hurdle. If the question here is  
21 whether these are relevant to willfulness,  
22 willfulness is asking about UpCodes' state of mind.  
23 I don't think anything UpCodes didn't know about  
24 sheds light on UpCodes' state of mind. So I don't  
25 feel like we've cleared the initial hurdle.

1           Whether or not we have to produce a  
2     privilege log, the burden of reviewing documents,  
3     mainly between counsel, as Your Honor pointed out,  
4     many of these are going to be privileged. The  
5     review of that doesn't lessen because we don't  
6     produce a privilege log.

7           I think, additionally, what are we going  
8     to search for? Are we going to search for  
9     copyright? I mean, copyright appears on every  
10    single ICC code. It's just a voluminous way to get  
11    at something that, at the end of the day, doesn't  
12    move the needle on whether UpCodes was willful or  
13    not because it didn't know what ICC's internal  
14    communications were, so it can't have had any  
15    bearing on their state of mind.

16           MR. MARCISZEWSKI: Your Honor, real  
17    quick, again, I mean, I'm not going to try to start  
18    doing narrowing or suggesting certain search terms  
19    live again, as I've done before. I'll just stick to  
20    the relevance issues.

21           Again, it's not that UpCodes relied on  
22    it. It's that if ICC is making the argument that  
23    the fact that UpCodes knew, obviously, we're going  
24    to argue that we believed it was not copyright  
25    infringement, what we did. Obviously, ICC is going



1 to argue that it was.

2 I think it is relevant that if UpCodes  
3 can say, hey, you're arguing that what we did is  
4 copyright infringement and we should have known  
5 about it and, therefore, you were willful -- whether  
6 there is internal documents and communications that  
7 ICC at times had questions about whether, you know,  
8 their copyright extended to what was adopted into  
9 law, that is very relevant that if ICC had mixed  
10 views on that. Then they can't just sit here and  
11 argue that, obviously, UpCodes should have known and  
12 that it's obviously willful infringement if they  
13 themselves, knowing even more information than  
14 UpCodes, came to similar conclusions that UpCodes,  
15 at least at certain points of times -- or were at  
16 least ambiguous to it.

17 THE COURT: Okay. Is the last one number  
18 19? Do we want to just touch upon that one?

19 MR. MARCISZEWSKI: Yes, Your Honor. I  
20 can do this quickly as well.

21 Just for an overview, what the request  
22 seeks is the documents that are related to proposed  
23 legislation that ICC and other similar organizations  
24 have proposed, that basically vindicates their  
25 position in this litigation, that code is being

1 incorporated by reference into law does not affect  
2 their copyrightability so long as the publisher  
3 makes them available for free for public viewing.

4 So to the extent there are non-privileged  
5 documents about the way that proposed bill would  
6 change the current law, that's relevant to the  
7 merits of ICC's position under the current law. And  
8 even if ICC believed its copyright interest were  
9 unaffected by being adopted into law, but just  
10 wanted the bill to clear up the uncertainty about  
11 the law, I would bring that back to the points  
12 they're making about willful infringement. Because  
13 if the law is uncertain, then there's no argument  
14 that UpCodes' infringement can be willful.

15 THE COURT: Ms. Wise?

16 MS. WISE: I thought UpCodes' prior  
17 position was related to the impact on market harm.  
18 I think our position on this is going to be  
19 remarkably similar to our position on Request 8,  
20 that ICC doesn't dispute that it makes its codes  
21 available for free in a read-only format. I don't  
22 think anything in the proposed Pro Codes legislation  
23 impacts that.

24 Whether -- there is legislation that's  
25 being considered, but is not law, would require ICC

1 to do something that it does already. I don't see  
2 how that bears on the fair-use analysis. I don't  
3 know how, again, ICC's subjective views about  
4 whether something will or will not become law at  
5 some point bears on UpCodes' state of mind.

6 And I don't think looking for our  
7 subjective opinions on that, again, really turn the  
8 dial one way or the other. ICC makes its reading  
9 room available for free. If the Pro Codes Act were  
10 to pass, ICC would make its reading room available  
11 for free. So how that bears on this copyright case  
12 is not particularly clear to me.

13 MR. MARCISZEWSKI: Your Honor, real  
14 quick, because opposing counsel is right, that we  
15 made the point about *Markham* that I failed to  
16 mention, so I just want to point that out in a very  
17 succinct way that I think it does -- it is wrong.  
18 Opposing counsel is right, but if the Pro Codes Act  
19 passes, they won't have to change what they do  
20 because it only talks about read-only access to  
21 being available.

22 But in the process of lobbying for and  
23 trying to get this bill passed, if there are  
24 communications about why it should be only read only  
25 and copy and paste shouldn't be allowed, or

1 downloading shouldn't be allowed, or if there's  
2 communication saying, you know what, if the  
3 Pro Codes Act passes, we're willing to -- if they  
4 say you have to be able to print it, too, or  
5 download it, that's fine with us, as long as there's  
6 not copy/paste, or whatever, you know, different  
7 iterations.

8 I could play the hypothetical game  
9 forever about what these communications could or  
10 couldn't say without looking at them. But I think  
11 the discussion with these features, in trying to  
12 pass a bill, if they really are strictly -- only  
13 wanted read-only or nothing, or if there's a  
14 willingness to have other features without fear that  
15 it might -- if we have to do this and it might  
16 affect our other revenues in order to ensure  
17 copyrightability, I think that is relevant then to  
18 market harm because then it shows that -- again, the  
19 arguments about the copy, paste, printing, downloads  
20 might be -- distinguishes without a difference that  
21 these -- UpCodes -- I mean, ICC would not intend it  
22 to actually affect its revenues if it's not, you  
23 know, always been gung ho about this or nothing. If  
24 it's willing to have those at some point in the  
25 bill, but it never came to be, I think that would be

1       then relevant from our end.

2                   MS. WISE:    I --

3                   THE COURT:   But it sounds like -- I mean,  
4       I -- it sounds like even now what you're really  
5       keeping it for is just a very narrow subset of what  
6       the request is asking for.  And I'm just wondering  
7       now that we've talked about market harm in the  
8       context of the potential revision to Requests -- I  
9       think it was 2 and 3 -- if that wouldn't encompass  
10      this idea that if you had to now change the  
11      functionality, it would -- you know, whether they  
12      did any analysis for a potential impact on the  
13      revenue.

14                  MR. MARCISZEWSKI:  Right.  And,  
15      Your Honor, I think that is correct, and it's one of  
16      the reasons why when I first started talking about  
17      this, I didn't bring up the market harm, because I  
18      believe market harm -- some of these other requests  
19      might address it a little bit better than this one.

20                  This one, again, is -- I would just  
21      reemphasize some of those willful infringement and  
22      as well as what ICC's position about its  
23      copyrightability of its codes -- or its copyright  
24      interest extend.

25                  MS. WISE:    And I think our position on

1 willfulness and copyrightability are the same as  
2 they were before. Copyrightability is objective and  
3 UpCodes' state of mind with respect to willfulness  
4 is not something that ICC's internal communications  
5 or even communications with others are -- is going  
6 to shed any light on.

7 THE COURT: Okay. At least as to Request  
8 Number 19, I'm going to -- I think on that one as  
9 the request is written and for all the reasons  
10 Ms. Wise has indicated, I'm really struggling to see  
11 why this is relevant.

12 I think the only other one that I owe you  
13 an answer on was 15; is that correct? Did I miss  
14 any?

15 MS. WISE: I think that's right.

16 MR. MARCISZEWSKI: And I guess 15 and 18  
17 are -- we kind of discussed them together. So if  
18 you want to flesh out the exact language of 18, we  
19 can.

20 The only point I want to make with --  
21 I'll just point out 18, the legal arguments I'm all  
22 going to make are the same. But just to point out  
23 that that RFP that we served, ICC served pretty much  
24 an identical RFP on us recently. And just to point  
25 out that UpCodes is willing to basically do the same

1 sort of production in a reciprocal manner, that  
2 whatever Your Honor believes is right for RFP 18,  
3 that's how we'll respond and produce the documents  
4 of the identical one served onto us by ICC.

5 THE COURT: Ms. Wise, did you guys serve  
6 the same request as 18?

7 MS. WISE: We did, but for a very  
8 different reason. So, as we said in our letter, ICC  
9 is not a party to the *NFPA v. UpCodes* case, but  
10 UpCodes is. If UpCodes made a statement against  
11 their interest in documents connected to the NFPA  
12 case, then that is relevant. If ICC had  
13 communications regarding the NFPA case, it isn't.

14 THE COURT: I see. Okay.

15 And of -- and it, of course, has you --  
16 okay.

17 So Mr. Marciszewski, I'm really -- I do  
18 apologize.

19 MR. MARCISZEWSKI: That's all right.

20 THE COURT: Can you just say it one more  
21 time just --

22 MR. MARCISZEWSKI: Oh --

23 THE COURT: -- maybe by the end of the  
24 conference, I can get it right.

25 MR. MARCISZEWSKI: Oh, Marciszewski.

1 THE COURT: Okay. Why -- can you just --  
2 why, again, do you need the documents you seek in  
3 RFP 18?

4 MR. MARCISZEWSKI: Oh, I think it's for  
5 similar reasons that opposing counsel has talked --  
6 while ICC is not a party to the litigation, it is  
7 definitely very, very similar issues; namely, the  
8 question of whether the codes, when adopted, are the  
9 law or they're still subject to copyright. And the  
10 same way that opposing counsel says if we've made a  
11 statement inconsistent, they would want that. We'd  
12 argue that if someone, you know, asks ICC about the  
13 position, and if they make a claim, something that's  
14 inconsistent, we'd want that as well.

15 And I just want to point, in our meet and  
16 confers, I believe one of the biggest issues with 18  
17 was about the privilege, you know, that there's a  
18 lot of these documents that meet privilege. And I  
19 would just argue that, for UpCodes, the burden is  
20 even higher. Given that we are a party in the  
21 litigation, there are a lot more privilege documents  
22 that we would have and a lot more documents than  
23 ICC.

24 So the burden is greater for us. We're  
25 seeking similar things, even if it's UpCodes as a



1 party versus it's the exact same issue, and does ICC  
2 take different positions when in litigation or, you  
3 know, their views on parallel litigation. And we  
4 are willing to make those productions and comply  
5 with these RFPs in a reciprocal manner, as I said.

6 THE COURT: But why is their view about a  
7 litigation they're not even involved in relevant?

8 MR. MARCISZEWSKI: It is because due to  
9 the legal issues. The legal issues are very  
10 parallel. And the one specifically that we're  
11 looking at is whether they've had the position  
12 that -- whether the codes, when adopted, are the  
13 law.

14 If they have made inconsistent statements  
15 regarding, say that NFPA, when they got their  
16 preliminary injunction denied, if there was  
17 questions like, well, maybe we don't have the  
18 copyright in the law. Or how can even expand it out  
19 to just inconsistent positions, but maybe market  
20 harm if there is -- that when the PI is denied,  
21 there's internal communication saying, yeah, this is  
22 going to really affect our market now, if we don't  
23 have copyright interest in it, or the reverse side,  
24 that they're not really worried about it, that can  
25 be relevant.

1           It's really about not so much that it was  
2           a party to this litigation, what it was doing, but  
3           that there are communications about this litigation  
4           that are very parallel issues. That is what we're  
5           searching for, to the extent that it's not  
6           privileged.

7           MS. WISE: I will just address the  
8           privilege concern. I find it hard to think of a  
9           document in this context that would not be  
10          privileged. And, again, the parties' stipulation  
11          that we don't have to produce a privilege log for  
12          communications between outside counsel and the  
13          parties is certainly something that they've agreed  
14          to, to reduce the burden on themselves. But it  
15          doesn't mean that we should review all sorts of  
16          documents that are going to be primarily, if not  
17          exclusively, privileged.

18          UpCodes, in its motion, offered no  
19          explanation for why it wanted these NFPA documents.  
20          And the arguments that it has raised now are about  
21          UpCodes' state of mind and copyrightability, neither  
22          of which ICC's subjective beliefs shed any light on.  
23          So I don't think that these are relevant.

24          If NFPA lost a preliminary injunction  
25          based on its copyrighted works, that doesn't tell

1     you anything about the copyrightability of ICC's  
2     works. It just doesn't. So I don't agree that that  
3     information, even if that conversation was  
4     happening, is relevant.

5             THE COURT: Okay. I think on 18, that  
6     one might be the -- again, on this one, I think,  
7     given the potential that all of these -- if not all,  
8     a large number of these communications would be  
9     privileged. The burden of having to go through  
10    them, review them, even without having to log them,  
11    still seems disproportional to the (inaudible). And  
12    I -- even then, I'm still not clear as to why they  
13    would be relevant to UpCodes' state of mind or to  
14    any potential issue here.

15            So as to 18, I'm going to deny the  
16    request. I think the only one I owe you an answer  
17    on is 15. I just want to take a look at -- I have  
18    the request in front of me, but I just want to take  
19    a look at the 2020 decision, I guess, and what the  
20    parties have been calling "Copyright 1." And I will  
21    just memo endorse the last letter, giving you a  
22    decision on 15.

23            MS. WISE: Okay. Thank you, Your Honor.

24            THE COURT: Is there anything --

25            MR. MARCISZEWSKI: Thank you, Your Honor.

1 THE COURT: Okay. If there's nothing  
2 else, then I'll issue that relatively shortly.  
3 Thank you, everyone.

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## 1 C E R T I F I C A T E

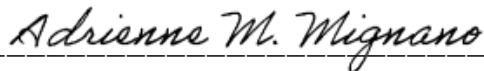
2

3 I, Adrienne M. Mignano, certify that the  
4 foregoing transcript of proceedings in the case of  
5 International Code Council, Inc. v. UpCodes, Inc.;  
6 Docket #17CV6261 was prepared using digital  
7 transcription software and is a true and accurate  
8 record of the proceedings.

9

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11 Signature



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ADRIENNE M. MIGNANO, RPR

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14 Date: August 11, 2023

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